

**Notice of Allowability**

Application No.

10/009,566

Examiner

Janet L. Coppins

Applicant(s)

TAKEMOTO ET AL.

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Applicants' After-Final Amendment of August 15, 2005.
2. ☒ The allowed claim(s) is/are 1-3,22-24,50 and 51.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-3, 22-24, 50, and 51 are pending in the instant application.

#### ***Response to Amendment***

1. Receipt is acknowledged of Applicants' After Final Amendment, filed August 15, 2005, which has been reviewed by the Examiner and entered of record in the file.
2. Accordingly, claims 25-49 have been cancelled, and claims 50 and 51 have been amended.

#### ***Terminal Disclaimer***

3. The terminal disclaimer filed on August 15, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Pat. No. 6,559,146 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Claim Rejections - 35 USC § 112***

4. Claims 1-3 previously rejected under 35 U.S.C. 112, first paragraph, as not being enabled. In view of Applicants' amendatory changes to the claims, the rejections have been obviated and are withdrawn.

#### ***Double Patenting***

5. Claims 1-3 and 22-24 previously rejected under the judicially created doctrine of obviousness-type double patenting over U.S. Pat. No. 6,559,146. Applicants have filed a terminal disclaimer, thereby rendering the rejection moot; accordingly, the Examiner withdraws the rejections.

### **EXAMINER'S AMENDMENT**

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

A) On page 3 of the August 15, 2005 Amendments to the Claims:

Claim 1: second line from the top, please delete the term "pyridily" and replace with the term "pyridyl"

B) On page 5 of the August 15, 2005 Amendments to the Claims:

Claim 50: eighth line from the top, please delete the term "pyridily" and replace with the term "pyridyl"

C) On page 6 of the August 15, 2005 Amendments to the Claims:

Claim 51: thirteenth line from the top, please delete the term "pyridily" and replace with the term "pyridyl".

### ***Allowable Subject Matter***

7. Claims 1-3, 22-24, 50, and 51 are allowable, as newly renumbered as claims 1-8.

The following is an examiner's statement of reasons for allowance: This invention relates to novel aminophenoxyacetamide compounds that have neuroprotective activity, and their pharmaceutical compositions. The claimed compounds are found allowable because certain aminophenoxyacetamide compounds are known to those skilled in the art as useful neuroprotectants, however the aspect of preparing the instant aminophenoxyacetamide-piperidyl

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compounds according to the claimed formula (I), wherein Q' is hydrogen or phenyl, pyridyl, quinolyl, isoquinolyl, benzothiazole, benzimidazole, morpholinyl, or a carbocyclic group, is novel and unobvious. The closest of prior art fails to teach or render obvious the preparation of the aforementioned compounds that contain the same aminophenoxyacetamide-piperidyl formulae as instantly claimed. For example, U.S. Patent No.6,559,146 B1 discloses similar aminophenoxyacetic acid derivatives, however Applicants have amended the instant claims to differentiate from the '146 patent, as well as filing a terminal disclaimer. Therefore, the prior art of record does not teach or fairly suggest the instant claimed compounds and compositions or their utility as neuroprotective agents.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

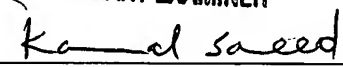
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 571.272.8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Coppins  
September 28, 2005

KAMAL A. SAEED, PH.D.  
PRIMARY EXAMINER

  
for Joseph K. McKane  
Supervisory Patent Examiner, Art Unit 1626